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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/788,613	01/24/97	PAYNE J	6328-117

LM12/0517
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EXAMINER
CALDWELL, A

ART UNIT	PAPER NUMBER
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2758

16

DATE MAILED: 05/17/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/788,613

Applicant(s)
Payne et al.

Examiner
Andrew Caldwell

Group Art Unit
2758



☒ Responsive to communication(s) filed on Feb 16, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-177 is/are pending in the application.

Of the above, claim(s) 156-177 is/are withdrawn from consideration.

☒ Claim(s) 51, 52, and 84-155 is/are allowed.

☒ Claim(s) 1-50 and 56-83 is/are rejected.

☒ Claim(s) 53-55 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 14-15

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Part III DETAILED ACTION

Remarks

1. This Office action is responsive to the reply filed on February 16, 1999 and mailed on February 8, 1999. Claims 1-155 are presented for examination. Claims 156-177 are withdrawn from consideration in accordance with the following restriction requirement.

Election/Restriction

2. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-155 are drawn to a system and method for *transmitting* data from an information source to a central broadcast server, *preprocessing* the data at the central broadcast server, transmitting the data to remote receivers in communication with computing devices, and *instantaneously notifying* the computing devices upon receipt of the preprocessed data regardless of whether the computing devices are on or off, classified in Class 709, subclass 219;

II. Claims 156-177 are drawn to a method for *broadcasting* data including an Internet address location to a user in communication with one of a plurality of receivers wherein the

Internet address location is not broadcast in response to a request for the Internet address location by the user,
classified in Class 709, subclass 228.

3. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as a method for instantaneously notifying a computing device upon receipt of preprocessed data classified in different Classes/subclasses. And, this combination, Invention I, as claimed does not require the particulars of the subcombination of Invention II as claimed because the Invention I does not explicitly require the step of *broadcasting* data including an Internet address location to a user in communication with one of a plurality of receivers wherein the Internet address location is not broadcast in response to a request for the Internet address location by the user. The subcombination has separate utility such as a method of pushing data to a client system, classified in a different Class/Subclass.

See M.P.E.P. § 806.05(d).

20. These inventions are distinct for the reasons given above, and the search required for each Group is different and not co-extensive for examination purpose.

4. For example, the searches for the two inventions would not be co-extensive because these groups would require different searches on PTO's classification class and subclass as following:

(a) the Group I search (claims 1-155) would require use of search Class 709, subclass 219 (not required for the invention II).

(b) the Group II search (claims 156-177) would require use of search Class 709, subclass 228 (not required for the invention I).

5. Since applicant has received an action on the merits for the originally presented invention, this invention has been *constructive elected by original presentation for prosecution on the merits*. Accordingly, claims 156-177 are withdrawn from consideration as being directed to a non-elected invention. See 37 C.F.R 35 § 1.142(b) and M.P.E.P. § 821.03.

Information Disclosure Statement

6. The information disclosure statement filed on September 16, 1997 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. However, the IDS has been considered in part because the Examiner believes that the references were submitted to the Office but not

properly matched with the application file. This problem occasionally arises when applicants submit a large number of references for consideration. Since it would be unfair to have the Applicants submit additional copies of the cited U.S. patents when they are readily available to the Examiner, all U.S. patents and SIR's have been considered. If the Applicants wish the cited non-patent literature to be considered, a copy of the reference must be resubmitted.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

'958 v. Ammons and '721

8. Claims 1-3, 14-25, 29-36, 44, 49-50, 60-66, and 78-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCoy et al., U.S. Patent No. 5,790,958, in view of Ammons, B., "RBDS for Your Station!" <http://www.crlsystems.com/crl/tech/rbds.htm>, Circuit Research Labs, Inc., pp. 1-13, Sep. 1995, and May, U.S. Patent No. 5,043,721, for the reasons given in the last Office action.

9. Claims 4-6 and 67-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCoy in view of Ammon and May and Schwob, U.S. Patent No. 5,732,338, for the reasons given in the last Office action.

10. Claims 7-13, 59, 70-77, and 82-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCoy in view of Ammons and May and Rossman, U.S. Patent No. 5,809,415, and Jacobson, U.S. Patent No. 5,442,652.

11. Claims 7-13, 59, and 70-77 are rejected for the reasons given in the last Office action.

12. As to claim 82, it is a method claim corresponding to apparatus claim 73. Since it does not teach or define above the information in the corresponding apparatus claim, it is rejected under the same basis.

13. As to claim 83, McCoy teaches a system wherein said computing device comprises a computer (Fig. 1 elem. 20).

14. Claims 37-43, 45-48, 56-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCoy in view of Ammons and May and Beam, M., "A Summary of Broadcasting Technologies and Potential Applications in Today's Market,"

http://www.dungeon.com/~start/rds_0030.html, pp. 1-8, 1994, for the reasons given in the last Office action.

15. Claims 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCoy in view of Ammon and May and Geiger, U.S.

Patent No. 5,701,302, for the reasons given in the last Office action.

Allowable Subject Matter

16. Claims 53-55 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

17. Claims 51-52 and 84-155 are allowed.

18. The following is a statement of reasons for the indication of allowable subject matter:

As to claim 51, the prior art of record does not teach the step of preprocessing data in a central broadcast server as specified in the originally presented version of claim 51, which depended on claim 1, in combination with the step of transmitting the preprocessed data to receivers communicating with computing devices wherein the computing devices are instantaneously notified upon receipt of the preprocessed data regardless of whether the computing devices are on or off. Claims 52 and 84-155 are allowed because they depend upon claim 51.

Response to Arguments

19. Regarding claims 1-50, and 56-81, the Applicants' arguments filed on February 16, 1999 have been fully considered but they

are not persuasive. The Applicants are arguing in substance that all rejections under 35 U.S.C. § 103(a) are improper because they include the Ammons reference, which does not predate the Applicants' earliest provisional filing date by more than one year. All references that qualify as prior art under 35 U.S.C. § 102 also qualify under 35 U.S.C. § 103. Ex parte Andresen, 212 U.S.P.Q. 100, 102 (Bd. Pat. App. & Inter. 1981). In this case, the Ammons reference was published in September 1995, which is prior to the Applicants' earliest provisional filing date of January 26, 1996. Ammons is therefore a reference under 35 U.S.C. § 102(a) and is also a reference under 35 U.S.C. § 103. For these reasons, the Applicants' argument is not deemed persuasive.

Conclusion

20. As to the prior art of record cited by the Applicants in the IDS filed on September 16, 1997, the Examiner has considered yet fails to see the relevance of the following: 4,356,546; 5,893,339; 5,008,935; 5,045,852; 5,109,486; 5,136,523; 5,247,614; 5,295,244; 5,325,505; 5,341,425; 5,347,632; 5,367,670; 5,377,354; 5,394,522; 5,396,560; 5,459,458; 5,481,255; 5,493,692; 5,510,778; 5,510,808; 5,537,856; 5,544,320; 5,544,354; H1641; 5627,978; 5,634062.

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS

ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Caldwell, whose telephone number is (703) 306-3036. The examiner can normally be reached on M-F from 8:30 a.m. to 5:00 p.m. EST.

If attempts to reach the examiner by phone fail, the examiner's supervisor, Ahmad Matar, can be reached at (703) 305-4731. Additionally, the fax phone for Art Unit 2758 is (703) 308-5357.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at (703) 305-9600.

Andrew Caldwell
May 3, 1999


ZARNI MAUNG
PRIMARY EXAMINER